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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/627,647	07/28/2000	Yves Fouillet	GENSET.077AUS	2266

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EXAMINER

SISSON, BRADLEY L

ART UNIT	PAPER NUMBER
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1634

DATE MAILED: 05/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

814.

## Office Action Summary

### Application No.

09/627,647

### Applicant(s)

FOUILLET ET AL.

### Examiner

Bradley L. Sisson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-91 is/are pending in the application.
- 4a) Of the above claim(s) 13-51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 52-91 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/31/03 &amp; 12/29/03</u> | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Specification*

1. The specification is objected to as documents have been improperly incorporated by reference. In particular, the specification states that each of the cited documents are incorporated in their entirety. Such omnibus language fails to specify what specific information applicant seeks to incorporate by reference and similarly fails to teach with detailed particularity just where that specific information is to be found in each of the cited documents. As set forth in *Advanced Display Systems Inc. v. Kent State University* (Fed. Cir. 2000) 54 USPQ2d at 1679:

Incorporation by reference provides a method for integrating material from various documents into a host document--a patent or printed publication in an anticipation determination--by citing such material in a manner that makes it clear that the material is effectively part of the host document as if it were explicitly contained therein. *See General Elec. Co. v. Brenner*, 407 F.2d 1258, 1261-62, 159 USQP 335, 337 (D.C. Cir. 1968); *In re Lund*, 376 F.2d 982, 989, 153 USPQ 625, 631 (CCPA 1967). **To incorporate material by reference, the host document must identify with detailed particularity what specific material it incorporates and clearly indicate where that material is found in the various documents.** *See In re Seversky*, 474 F.2d 671, 674, 177 USPQ 144, 146 (CCPA 1973) (providing that incorporation by reference requires a statement "clearly identifying the subject matter which is incorporated and where it is to be found"); *In re Saunders*, 444 F.2d 599, 602-02, 170 USPQ 213, 216-17 (CPA 1971) (reasoning that a rejection or anticipation is appropriate only if one reference "expressly incorporates a particular part" of another reference); *National Latex Prods. Co. v. Sun Rubber Co.*, 274 F.2d 224, 230, 123 USPQ 279, 283 (6<sup>th</sup> Cir. 1959) (requiring a specific reference to material in an earlier application in order to have that material considered a part of a later application); *cf. Lund*, 376 F.2d at 989, 13 USPQ at 631 (holding that **a one sentence reference to an abandoned application is not sufficient to incorporate from the abandoned application into a new application**). (Emphasis added.)

Accordingly, the cited documents are not considered to have been properly incorporated by reference and as such, have not been considered with any effect towards their fulfilling, either in

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part or in whole, the enablement, written description, or best mode requirements of 35 USC 112, first paragraph.

2. A substitute specification not including the claims is required pursuant to 37 CFR 1.125(a) because the top margin of the original specification was such that when retention holes were introduced, the first line of text was affected.

A substitute specification filed under 37 CFR 1.125(a) must only contain subject matter from the original specification and any previously entered amendment under 37 CFR 1.121. If the substitute specification contains additional subject matter not of record, the substitute specification must be filed under 37 CFR 1.125(b) and (c)

### ***Claim Objections***

3. A series of singular dependent claims is permissible in which a dependent claim refers to a preceding claim which, in turn, refers to another preceding claim.

A claim, which depends from a dependent claim, should not be separated by any claim, which does not also depend from said dependent claim. In the present case, claims 87, 90, and 91 are separated from independent claim 1 by independent claim 79, and claims 80-86, 88, and 89 that also depend from said claim 79. It should be kept in mind that a dependent claim may refer to any preceding independent claim. In general, applicant's sequence will not be changed. See MPEP § 608.01(n).

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 73, 74, 77, 78, 80, 81, and 84-91 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Attention is directed to the decision in *University of Rochester v. G.D. Searle & Co.* 68 USPQ2D 1424 (Fed. Cir. 2004) at 1428:

To satisfy the written-description requirement, the specification must describe every element of the claimed invention in sufficient detail so that one of ordinary skill in the art would recognize that the inventor possessed the claimed invention at the time of filing. *Vas-Cath*, 935 F.3d at 1563; see also *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 [41 USPQ2d 1961] (Fed. Cir. 1997) (patent specification must describe an invention and do so in sufficient detail that one skilled in the art can clearly conclude that “the inventor invented the claimed invention”); *In re Gosteli*, 872 F.2d 1008, 1012 [10 USPQ2d 1614] (Fed. Cir. 1989) (“the description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed”). Thus, an applicant complies with the written-description requirement “by describing the invention, with all its claimed limitations, not that which makes it obvious,” and by using “such descriptive means as words, structures, figures, diagrams, formulas, etc., that set forth the claimed invention.” *Lockwood*, 107 F.3d at 1572.

New Matter

6. Claims 73, 74, 77, 78, 80, 81, and 84-91 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement in that they contain new matter.

7. Page 20, first paragraph, of the response of 23 December 2003, hereinafter the response, applicant directs attention to “page 16, lines 11-13; page 17, lines 9-19; and pages 62-69” as providing support for the amendments to the claims, including the addition of new claims 72-91.

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A review of the specification, including those passages to which applicant has directed attention with particularity, has failed to locate support for the limitations recited in new claims 73, 74, 77, 78, 80, 81, and 84-91. Accordingly, and in the absence of convincing evidence to the contrary, claims 73, 74, 77, 78, 80, 81, and 84-91 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 1-12 and 52-91 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kopp et al. in view of Poser et al., and US Patent 5,587,128 (Wilding et al.).

12. Kopp et al., disclose a device comprising a microfluidic substrate comprising at last one sample pathway for sample flow. The device uses pressure to cause a fluid to flow along the sample path whereby it undergoes cycles between at least two different and predetermined temperatures. The device further comprises at least one inlet and at least one outlet basin, where the at least one inlet basin is positioned at a first end and that the device is configured such that the fluid flows from the sample inlet basin to the sample pathway. The microfluidic substrate consists essentially of silicon. The device further comprises a thermostat so to regulate the temperature at least one region along the sample path.

13. While the device of Kopp et al., uses a series of regions that keep the temperature at set temperatures, Kopp et al., do not disclose using elements that can cycle the temperature at a given region. Kopp et al., also do not disclose a device that comprises a plurality of sample flow paths in parallel.

14. Poser et al., disclose the design and development of miniaturized thermocyclers capable of cycling the temperature of fluid samples.

15. Poser et al., page672, right column, provides motivation in using miniaturized thermocyclers.

First, the heating and cooling elements possess small volumes and small heat capacities. A consequent reduction of parasitic heat capacities is a precondition of high heating and cooling rates of about  $15\text{-}40\text{ K s}^{-1}$ . Secondly, heaters and sensors for local temperature measurement can be integrated as thin-film resistors in a very close connection to the

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chamber containing the liquid. Thirdly, the choice of geometries and materials in microsystems allows configurations of very well-controlled local heat flow during all processes such as heating, cooling and temporal thermostabilization (8). Fourthly, by shrinking the reaction volumes to the microtiter range, the consumption of expensive or dangerous reaction materials is also decreased.

16. Poser et al., teaches that they have prepared devices that consist essentially of silicon and that have from one to ten sample regions that undergo temperature cycling associated with conducting PCR.
17. Poser et al., do not teach having multiple sample paths in parallel, or that sample reagent ports can enter /empty into the sample flow path.
18. Wilding et al., disclose a mesoscale device consisting essentially of silicon and which can comprise a plurality of parallel sample flow paths (column 21). Wilding et al., column 22, discloses their device as optionally comprising ports that allow for reagents to be introduced into the sample flow path.
19. In view of the teachings of the prior art of record, it would have been obvious to one of ordinary skill in the relevant art to have modified the device of Kopp et al., such that the elongated sample path did not travel across three separate temperature zones so to achieve temperature cycling, but rather, comprised at least one region that would allow for temperature cycling, as disclosed by Poser et al. As presented above, Poser et al., provides motivation for using miniaturized thermocyclers, and accordingly, the ordinary artisan would have been amply motivated to perform this adaptation and simplification, and would have had a reasonable expectation of success in doing so.
20. It would also been obvious to said ordinary artisan to have further modified the device of Kopp et al., such that it comprises multiple sample paths that were in parallel, and that optionally



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comprised portals that permit the introduction of reagents into the sample flow path, as disclosed by Wilding et al. As noted above, the devices disclosed by Kopp et al., Poser et al., and Wilding et al., are all described as being useful in conducting thermocycling associated with performing polymerase chain reaction. Accordingly, the range of temperatures that the one or more temperature cycling regions can cycle through, is rendered obvious by the prior art of record. To the extent that the claims recite temperature ranges, and/or shape of sample flow paths, such embodiments are considered to be the result of routine optimization. It is well settled that routine optimization is not patentable, even if it results in significant improvements over the prior art. In support of this position, attention is directed to the decision in *In re Aller, Lacey, and Hall*, 105 USPQ 233 (CCPA 1955):

Normally, it is to be expected that a change in temperature, or in concentration, or in both, would be an unpatentable modification. Under some circumstances, however, changes such as these may impart patentability to a process if the particular ranges claimed produce a new and unexpected result which is different in kind and not merely in degree from the results of the prior art. *In re Dreyfus*, 22 C.C.P.A. (Patents) 830, 73 F.2d 931, 24 USPQ 52; *In re Waite et al.*, 35 C.C.P.A. (Patents) 1117, 168 F.2d 104, 77 USPQ 586. Such ranges are termed "critical" ranges, and the applicant has the burden of proving such criticality. *In re Swenson et al.*, 30 C.C.P.A. (Patents) 809, 132 F.2d 1020, 56 USPQ 372; *In re Scherl*, 33 C.C.P.A. (Patents) 1193, 156 F.2d 72, 70 USPQ 204. However, even though applicant's modification results in great improvement and utility over the prior art, it may still not be patentable if the modification was within the capabilities of one skilled in the art. *In re Sola*, 22 C.C.P.A. (Patents) 1313, 77 F.2d 627, 25 USPQ 433; *In re Normann et al.*, 32 C.C.P.A. (Patents) 1248, 150 F.2d 708, 66 USPQ 308; *In re Irmscher*, 32 C.C.P.A. (Patents) 1259, 150 F.2d 705, 66 USPQ 314. More particularly, where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *In re Swain et al.*, 33 C.C.P.A. (Patents) 1250, 156 F.2d 239, 70 USPQ 412; *Minnesota Mining and Mfg. Co. v. Coe*, 69 App. D.C. 217, 99 F.2d 986, 38 USPQ 213; *Allen et al. v. Coe*, 77 App. D. C. 324, 135 F.2d 11, 57 USPQ 136. (Emphasis added)

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21. For the above reasons, and in the absence of convincing evidence to the contrary, claims 1-12 and 52-91 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kopp et al. in view of Poser et al., and US Patent 5,587,128 (Wilding et al.).

### *Conclusion*

22. Rejections and/or objections that appeared in the prior Office action and not repeated hereinabove have been withdrawn.

23. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

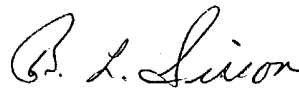
24. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley L. Sisson whose telephone number is (571) 272-0751. The examiner can normally be reached on 6:30 a.m. to 5 p.m., Monday through Thursday.

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26. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on (571) 272-0782. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

27. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Bradley L. Sisson  
Primary Examiner  
Art Unit 1634

BLS  
27 April 2004